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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/068,381 | 02/06/2002 | Steven R. Donovan | RIC-99-055-C1 | 8503 |
| 25537 | 7590 | 11/29/2005 | EXAMINER MARCELO, MELVIN C | |
| MCI, INC 1133 19TH STREET NW 4TH FLOOR WASHINGTON, DC 20036 | | | ART UNIT 2662 | PAPER NUMBER |

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/068,381 | DONOVAN, STEVEN R. |
| | Examiner Melvin Marcelo | Art Unit 2662 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: Claim 1 is an apparatus claim which corresponds to patent 6,434,143 method claim 1. In claim 1, line 7, it appears that "sending an SIP acknowledge message" should be --means for sending an SIP acknowledge message-- in order to be consistent with the rest of the apparatus claim. Appropriate correction is required.

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims {21-27} and {28-39} are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims {1-7} and {8-12, 14, 13 and 15-19} of prior U.S. Patent No. 6,434,143. This is a double patenting rejection.

The application method claims and patent method claims are directed to the same invention. For comparison, representative application claim 21 is compared to patent claim 1 in the table below. The function of "transmitting" is identical to the function of "sending"; otherwise, the only differences appear to be grammatical.

Applicant is requested to state the differences in the claimed subject matter between these sets of claims.

| Application 10/068,381 | Patent 6,434,14 |
|---|---|
| <p>21. A method of signaling the deposit of a message with an integrated messaging system on an internet protocol based network, comprising:</p> <p>transmitting a session initiation protocol INVITE request to an integrated messaging system, the session initiation protocol INVITE request indicating a message deposit action;</p> <p>receiving a session initiation protocol agreement message from the integrated messaging system, the session initiation protocol agreement message corresponding to the session initiation protocol INVITE message, the session initiation protocol agreement message also indicating an agreement to participate in the message deposit action; and</p> <p>sending an session initiation protocol acknowledge message to the integrated messaging system, the session initiation protocol acknowledge message confirming receipt of the session initiation protocol message indicating an agreement to participate in the message deposit action.</p> | <p>1. A method of signaling an Integrated Messaging System (IMS) on an Internet Protocol (IP) based network to deposit a message, comprising the steps of:</p> <p>sending a Session Initiation Protocol (SIP) INVITE request to the IMS indicating a message deposit action;</p> <p>receiving a corresponding SIP message from the IMS agreeing to participate in the message deposit action; and</p> <p>sending an SIP acknowledge message to the IMS confirming receipt of the corresponding SIP message.</p> |

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims {1-7}, {8-19}, {20} and {40-43} are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims {1-7}, {8-12, 14, 13 and 15-19}, {20} and {1-4} of U.S. Patent No. 6,434,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the patented method claims in an apparatus as claimed in the application, wherein a skilled artisan would have been motivated to practice the patented method claims by implementing it in a physical embodiment -- i.e. an apparatus. Representative application claim 1 is compared to patent claim 1 in the table below.

| Application 10/068,381 | Patent 6,434,143 |
|---|---|
| <p>1. An apparatus for signaling an Integrated Messaging System (IMS) on an Internet Protocol (IP) based network to deposit a message, comprising:</p> <p>means for sending a Session Initiation Protocol (SIP) INVITE request to the IMS indicating a message deposit action;</p> <p>means for receiving a corresponding SIP message from the IMS agreeing to participate in the message deposit action; and</p> <p>sending an SIP acknowledge message to the IMS confirming receipt of the corresponding SIP message.</p> | <p>1. A method of signaling an Integrated Messaging System (IMS) on an Internet Protocol (IP) based network to deposit a message, comprising the steps of:</p> <p>sending a Session Initiation Protocol (SIP) INVITE request to the IMS indicating a message deposit action;</p> <p>receiving a corresponding SIP message from the IMS agreeing to participate in the message deposit action; and</p> <p>sending an SIP acknowledge message to the IMS confirming receipt of the corresponding SIP message.</p> |

Information Disclosure Statement

5. Applicant is requested to resubmit the IDS forms 1449 for the statements dated 02/06/2002 and 07/03/2002 since these forms appeared to have been lost during the paper conversion to electronic image file wrapper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Marcelo whose telephone number is 571-272-3125. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melvin Marcelo
Primary Examiner
Art Unit 2662

November 14, 2005